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Adjustment date: 02/23/2006 SFELEKE1  
01/20/2006 BHINES 00000004 180580 10611418  
01 FC:1252 450.00 CR

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re Application of:

Dennis R. McKEAN et al.

Confirmation No.: 1933

Serial No.: 10/611,418

Group Art Unit: 1774

Filing Date: June 30, 2003

Examiner: Lawrence D. FERGUSON

Title: SLIDERS BONDED BY A DEBONDABLE SILICON-BASED ENCAPSULANT

**REQUEST FOR REFUND**

Mail Stop 16  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

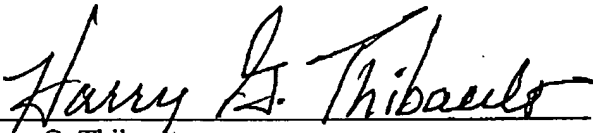
This is a request for a refund of ~~\$450.00~~ which was charged to our Deposit Account No. 18-0580, as shown on our statement dated January 2006 for the above-identified application. A copy of the monthly statement in which the charge appears is included with this request.

On December 20, 2005, we submitted a Transmittal and Response to Requirement for Restriction. A copy of the Return Receipt Post Card, Transmittal, and Response to Requirement for Restriction are enclosed. The Response was timely filed, within three months of the mailing date of the Office Action. A copy of the Office Action is also enclosed verifying the mailing date as September 23, 2005, and the period for reply being "3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION."

Please deposit the refund into Deposit Account No. 18-0580.

Respectfully submitted,

By:

  
Harry G. Thibault  
Registration No. 26,347

Reed Intellectual Property Law Group  
1400 Page Mill Road  
Palo Alto, California 94304-1124  
(650) 251-7700 Telephone  
(650) 251-7739 Facsimile

F:\Document\148000001\Refund Request - Deposit Account Charge Error.DOC

<b>TRANSMITTAL FORM</b> <i>(to be used for all correspondence after initial filing)</i>	Application Number	10/611,418 2004 FEB -9 PM 4:41	
	Filing Date	June 30, 2003	
	First Named Inventor	Dennis R. McKean	
	Art Unit	1774	
	Examiner Name	Lawrence D. Ferguson	
Mail Stop	16	Attorney Docket Number	HSJ9-2003-0022US1

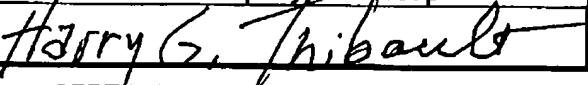
**ENCLOSURES (Check all that apply)**

<input checked="" type="checkbox"/> No fee due <input type="checkbox"/> Fee(s) due: \$ _____ <input type="checkbox"/> Check enclosed <input type="checkbox"/> Charge Deposit Account No. 18-0580 <input type="checkbox"/> 37 CFR § 1.16 <input type="checkbox"/> 37 CFR § 1.17 <input checked="" type="checkbox"/> The Commission is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 18-0580 <input checked="" type="checkbox"/> Return postcard <input type="checkbox"/> Amendment/Response <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) - _____ <input type="checkbox"/> Affidavits/declaration(s) - _____ <input type="checkbox"/> ___-Month Extension of Time	<input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Information Disclosure Statement & PTO-1449 Form(s) <input type="checkbox"/> Cited reference copy(ies) <input type="checkbox"/> Response to Missing Parts / Incomplete Application <input type="checkbox"/> Declaration(s) by Inventor(s) <input type="checkbox"/> Preliminary Amendment <input type="checkbox"/> Updated Application Data Sheet <input type="checkbox"/> Drawing(s) - ___ Sheets <input type="checkbox"/> Compact Disk(s) - ___ CD(s) <input type="checkbox"/> Petition <input type="checkbox"/> Power of Attorney & Address Indication Form	<input type="checkbox"/> Revocation of & New Power of Attorney, Address Indication Form <input type="checkbox"/> Request for Refund <input type="checkbox"/> After Allowance Communication to a Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input checked="" type="checkbox"/> Other Enclosure(s) (see remarks):  <b><u>Request for Refund (w/copies of 1/06 Deposit Account Statement; Return Receipt Post Card, Transmittal, Response to Requirement for Restriction - all sent to the PTO on 12/20/05; and Office Action mailed from the PTO on 9/23/05)</u></b>
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**REMARKS**

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**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm or Individual Name (print/type)	Harry G. Thibault, Reg. No. 26,347 Reed Intellectual Property Law Group	Telephone	(650) 251-7700
Signature		Date	February 3, 2006

**CERTIFICATE OF TRANSMISSION/MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Name (print/type)	Joe Clark		
Signature		Date	February 3, 2006



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Trademark Office**

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**Deposit Account Statement**

Requested Statement Month: January 2006  
 Deposit Account Number: 180580  
 Name: REED INTELLECTUAL PROPERTY LAW GROUP  
 Attention: MARILYN B. MCKENNA, PATENT ADMINISTRATOR  
 Address: 1400 PAGE MILL ROAD  
 City: PALO ALTO  
 State: CA  
 Zip: 94304  
 Country: UNITED STATES OF AMERICA

DATE	SEQ	POSTING REF TXT	ATTORNEY DOCKET NBR	FEE CODE	AMT	BAL
01/04	12	10392270		9204	-\$700.00	\$23,024.73
01/04	106	11148766	1950-0067	8021	\$80.00	\$22,944.73
01/12	39	11028702	2335-0008TW4,VE4,GC4	8007	\$60.00	\$22,884.73
01/17	25	60638835	2335-0016TWVE/GC	8007	\$60.00	\$22,824.73
01/17	629	10336666	8500-0271	8021	\$40.00	\$22,784.73
01/20	4	10611418	HSJ9-2003-0022US1	1252	\$450.00	\$22,334.73
01/23	137	11334997	1950-0076	1111	\$500.00	\$21,834.73
01/23	138	11334997	1950-0076	1311	\$200.00	\$21,634.73
01/24	69	6111121	1950-0032.10	8021	\$40.00	\$21,594.73
01/24	75	6515084	1950-0032.12	8021	\$40.00	\$21,554.73
01/24	80	6806325	1950-0032.13	8021	\$40.00	\$21,514.73
01/27	1	10222763	8200-0006.21	1201	-\$200.00	\$21,714.73
01/27	2	10222763	8200-0006.21	1201	\$88.00	\$21,626.73
01/30	212	60648093	2335-0015TWVE//GC	8007	\$60.00	\$21,566.73
01/31	163	11341085	2335-0015	1111	\$500.00	\$21,066.73
01/31	164	11341085	2335-0015	1311	\$200.00	\$20,866.73
01/31	165	11341085	2335-0015	1202	\$700.00	\$20,166.73

START SUM OF  
BALANCE CHARGES  
\$22,324.73 \$3,058.00

SUM OF END  
REPLENISH BALANCE  
\$900.00 \$20,166.73

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Atty Dkt No.: HSJ9-2003-0022US1  
Reed IP Dkt No.: 4800-0001

Mailing Date: December 20, 2005

Inventor(s): Dennis R. McKean et al.

Serial No.: 10/611,418

Filing Date: June 30, 2003

Document(s):

Transmittal  
Response to Requirement for Restriction  
Return Post Card.



HGT/jc

RECEIVED BY THE UNITED STATES PATENT AND TRADEMARK OFFICE

COPY

# TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number **10/611,418**

Filing Date **June 30, 2003**

First Named Inventor **Dennis R. McKean**

Art Unit **1774**

Examiner Name **Lawrence D. Ferguson**

Attorney Docket  
Number **HSJ9-2003-00225US1**

Mail Stop **Amendment**

## ENCLOSURES (Check all that apply)

- ☒ **No fee due**  
☐ Fee(s) due: \$ \_\_\_\_\_  
☐ Check enclosed  
☐ Charge Deposit Account  
No. 18-0580  
☐ 37 CFR § 1.16  
☐ 37 CFR § 1.17  
☒ **The Commission is  
authorized to charge any  
underpayment or credit any  
overpayment to Deposit  
Account No. 18-0580**  
☒ **Return postcard**  
☒ **Amendment/Response**  
☐ After Final  
☐ Affidavits/declaration(s) -  
\_\_\_\_ Affidavits/declaration(s)  
☐ \_\_\_\_Month Extension of Time

- ☐ Terminal Disclaimer  
☐ Information Disclosure  
Statement & PTO-1449  
Form(s)  
☐ Cited reference copy(ies)  
☐ Response to Missing Parts /  
Incomplete Application  
☐ Declaration(s) by  
Inventor(s)  
☐ Preliminary Amendment  
☐ Updated Application Data  
Sheet  
☐ Drawing(s) - \_\_\_\_ Sheets  
☐ Compact Disk(s) - \_\_\_\_ CD(s)  
☐ Petition  
☐ Power of Attorney & Address  
Indication Form

- ☐ Revocation of & New Power of Attorney,  
Address Indication Form  
☐ Request for Refund  
☐ After Allowance Communication to a  
Technology Center (TC)  
☐ Appeal Communication to Board of  
Appeals and Interferences  
☐ Appeal Communication to TC (Appeal  
Notice, Brief, Reply Brief)  
☐ Other Enclosure(s) (see remarks):

### Claim Count

			Extra Claims	New Claim No.
Total Claims	31	- 31 =	0	
Independent Claims	3	- 3 =	0	

## REMARKS

**COPY**

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual Name  
(print/type) **Harry G. Thibault, Reg. No. 26,347  
Reed Intellectual Property Law Group**

Telephone **(650) 251-7700**

Signature **Harry G. Thibault**

Date **December 20, 2005**

## CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Name (print/type) **Joe Clark**

Signature **[Signature]**

Date **December 20, 2005**

Application No. 10/611,418  
Response dated December 20, 2005  
Response to Office Action dated August 23, 2005

Atty Dkt No. HSJ9-2003-0022US1  
Reed IP No. 4800-0001

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re Application of:

Dennis R. MCKEAN et al.

Confirmation No.: 1933

Serial No.: 10/611,418

Group Art Unit: 1774

Filing Date: June 30, 2003

Examiner: Lawrence D. FERGUSON

Title: SLIDERS BONDED BY A DEBONDABLE SILICON-BASED ENCAPSULANT

**RESPONSE TO REQUIREMENT FOR RESTRICTION**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is in response to the Requirement for Restriction mailed August 23, 2005, in which the Examiner required restriction between three groups of claims:

- I. Claims 1-21, drawn to a slider assembly;
- II. Claims 22-29, drawn to a method of producing a slider assembly; and
- III. Claims 30-31, drawn to a method for patterning an air-bearing surface of a slider

In response, applicants elect Group II, claims 22-29, without traverse. Applicants expressly reserve their right under 35 USC § 121 to file one or more divisional applications directed to the nonelected subject matter during the pendency of this application.

COPY



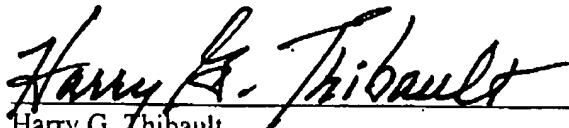
Application No. 10/611,418  
Response dated December 20, 2005  
Response to Office Action dated August 23, 2005

Atty Dkt No. HSJ9-2003-0022US1  
Reed IP No. 4800-0001

If the Examiner has any questions concerning this communication, or would like to discuss the application, the art, or other pertinent matters, he is welcome to contact the undersigned attorney at (650) 251-7700.

Respectfully submitted,

By:

  
Harry G. Thibault  
Registration No. 26,347

Reed Intellectual Property Law Group  
1400 Page Mill Road  
Palo Alto, California 94304-1124  
(650) 251-7700 Telephone  
(650) 251-7739 Facsimile

F:\Document\4800\0001\2d Restriction Requirement Response.DOC



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UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,418	06/30/2003	Dennis R. McKean	HSJ9-2003-0022US1	1933

23980 7590 09/23/2005

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT PAPER NUMBER

1774

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

4800-0001

9/26/05 (M)  
HOT DOCUMENT  
RS 12/23/05  
Last 3/23/06

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## Office Action Summary

Application No.

10/611,418

Applicant(s)

MCKEAN ET AL.

Examiner

Lawrence D. Ferguson

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(e). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-31 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the provisional election mailed July 29, 2005. Applicant elected group II, claims 22-31. The restriction requirement made on June 24, 2005 is withdrawn in favor of a new restriction requirement placing claims 30-31 in Group III as being drawn to a method for patterning an air-bearing surface of a slider. Claims 1-31 are pending in this case.

### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-21, drawn to a slider assembly, classified in class 428, subclass 41.9.
  - II. Claims 22-29, drawn to method of producing a slider assembly, classified in class 156, subclass 297.
  - III. Claims 30-31, drawn to a method for patterning an air-bearing surface of a slider, classified in class 216, subclass 33
3. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process

(MPEP § 806.05(f)). In the instant case, the product can be made by producing a slider assembly comprising arranging a plurality of extruded sliders each having an surface that are coplanar to one another.

Inventions I and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product can be made by producing an air bearing surface of a slider comprising applying a resist layer on an air-bearing surface of an extruded slider.

Inventions II and III are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)).

The inventions II and III are distinct, each from the other because: a method for patterning an air-bearing surface of a slider is not the same as a method for forming a slider assembly. In the method for patterning an air-bearing surface of a slider, the slider is already formed.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. A telephone call was made to Louis Wu on 5/27/2005, to request an oral election to the above restriction requirement, but did not result in an election being made.
6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Application/Control Number: 10/611,418

Page 5

Art Unit: 1774

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

*L.F.*

L. Ferguson  
Patent Examiner  
AU 1774

*Rena Dye*

RENA DYE  
SUPERVISORY PATENT EXAMINER

A.O. 1774 9/19/06